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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,919	02/14/2001	Yoichi Sugiyama	1422-0467P	9671
2292	7590	10/07/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			DOUYON, LORNA M	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 10/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/762,919	SUGIYAMA ET AL.
	Examiner	Art Unit
	Lorna M. Douyon	1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 July 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 3-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

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1. This action is responsive to the amendment filed on July 16, 2003.
2. The cancellation of claim 2 is acknowledged. Claims 1, 3-13 are pending.
3. The rejection of claims 9-11 under 35 U.S.C. 102(b) as being anticipated by Wilms is withdrawn in view of applicants' amendment and arguments therein.
4. The rejection of claims 1-13 under 35 U.S.C. 112, second paragraph is withdrawn in view of applicants' amendment.
5. The rejection of claims 1-3 and 5-8 under 35 U.S.C. 103(a) as being unpatentable over Wilms is withdrawn in view of applicants' amendment and arguments therein.
6. Claims 1, 3-8 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Partee et al. (US Patent No. 5,726,142), hereinafter "Partee" for the reasons set forth in the office action in paper number 11.
7. Claims 9-11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Partee as applied to the above claims, and further in view of Wilms for the reasons set forth in the office action in paper number 11.

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Response to Applicants' Arguments

8. Applicants' arguments filed on July 16, 2003 have been fully considered but they are not persuasive.

With respect to Partee, Applicants argue that the Table at column 3 and column 5 of Partee wherein the ratio of the sodium polyacrylate/sodium chloride is 0.089, 0.033, 0.079 and 0.033, respectively fail to satisfy or meet the requirements of the present invention, i.e., a ratio of 0.1 - 100. In addition, the contents of the surfactant in the Table at columns 3 and 5 fall outside the range of the content of the surfactant in the present invention. Applicants then argue that the present invention is distinguishable from Partee singularly or in combination with the secondary reference of Wilms.

The Examiner respectfully disagrees with the above argument because the ratio 0.089 and 0.079 of sodium polyacrylate/sodium chloride above, still read on 0.1, the minimum ratio required in the present claims. Even assuming these values do not overlap, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium MetalsCorp. of America v. Banner*, 778F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05I. Additionally, even assuming that the weight ratio of sodium polyacrylate/sodium chloride, and the content of surfactant in the Examples at columns 3 and 5 are outside the claimed range, a reference is not limited to working examples, see *In re Fracalossi*, 215 USPQ 569 (CCPA 1982). In col. 2, lines 37-42, the copolymer is present in an

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amount of up to about 5 wt%, and in col. 2, lines 21-29, the surfactant is present in an amount of up to about 40 wt%. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the proportions of the sodium polyacrylate, sodium chloride and surfactant of Partee through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Accordingly, the rejection based upon Partee, and the combination of Partee and Wilms for claims 9-11 and 13, are proper and is maintained.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (703) 305-3773. The examiner can normally be reached on Mondays-Fridays from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Technology Center is:

(703) 872-9311 - for Official After Final faxes
(703) 872-9310- for all other Official faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.

October 6, 2003

Lorna M. Douyon
Lorna M. Douyon
Primary Examiner
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